

Applicants: Kenneth H. Rosen
Serial No.: 10/055,104
Filing Date: January 23, 2002
Docket No.: 1209-2
Page 2

REMARKS

The Examiner has stated that the Declarations filed on January 23, 2002 and April 22, 2005 are defective. The Examiner contends that, specifically, the signature of inventor, John A. Rotondo is missing. This determination is respectfully traversed.

In each instance with respect to both the filing of the original Declaration on January 23, 2002 and the filing of Declaration under 37 C.F.R. §1.131 on April 22, 2005, declarations by both inventors were executed and signed. However, in each instance, each inventor signed a separate identical Declaration. Undersigned counsel submits that perhaps due to clerical misfiling, the Declarations signed by inventor, John A. Rotondo, were not maintained with the file.

Accordingly, in response to the Examiner's objection, submitted herewith are copies of both sets of Declarations as filed on January 23, 2002 and April 22, 2005, each separately executed by the inventors, Rosen and Rotondo. Reconsideration is respectfully requested.

The Examiner has indicated that the Declaration filed under 37 C.F.R. §1.131 on April 22, 2005 has been considered but it is ineffective to overcome the cited reference. While the Examiner has indicated that the Declaration provides sufficient evidence to establish conception of claimed invention, the Examiner, however, submits that the evidence

Applicants: Kenneth H. Rosen
Serial No.: 10/055,104
Filing Date: January 23, 2002
Docket No.: 1209-2
Page 3

is insufficient to establish diligence from a date prior to the date of the cited reference to either a constructive reduction to practice date or an actual reduction to practice date. This determination is respectfully traversed.

The Examiner cites three perceived insufficiencies.

First, with respect to Exhibit B, the Examiner states that Applicant has failed to establish diligence from a date prior to July 17, 2001 (the date of the cited Sheha et al. reference) to September 21, 2001. The Examiner further contends that Applicants' representative states "we need to elaborate more in the feature of preventing to storage of the wireless caller's location information in the network." As set forth in the attached Supplemental Declaration of Rohini K. Garg, the Patent Agent who prepared the application, this statement clearly refers to Agent Garg's desire to have the inventors clarify to her and elaborate further on information in the patent application which was already the subject matter of their invention. The Examiner's attention is called to the fact that Agent Garg's memo encouraged the inventor to elaborate more on the feature thus indicating that the feature was already disclosed to the Patent Agent rather than including new features. Accordingly, it is respectfully submitted that for the period from July 17, 2001 to September 21, 2001, diligence is established. Reconsideration is respectfully requested.

Applicants: Kenneth H. Rosen
Serial No.: 10/055,104
Filing Date: January 23, 2002
Docket No.: 1209-2
Page 4

Second, the Examiner also contends that from the period of Exhibit C, September 21, 2001 to Exhibit D, December 5, 2001, Applicant has failed to establish diligence. The Examiner further states that the application drafts referred to in Exhibits C and Exhibit D have not been provided. As set forth in the attached Supplemental Declaration of Agent Garg, these drafts were in existence at the time they were indicated as being forwarded to the inventors. However, no copies of those drafts remain in the application file as they were intermediate drafts which were supplanted by the filing of the actual application. The e-mail of September 21, 2001 acknowledging the transmission of a draft application includes a document number indicating an attachment. The letter of December 5, 2001 also indicates that enclosures were included. These indications together, with Agent Garg's declaration, should be sufficient to establish that drafts were in fact included.

Accordingly, it is respectfully submitted that diligence has been established for the time period between September 21, 2001 and December 5, 2001. Reconsideration is respectfully requested.

Finally, the Examiner contends that from the period of Exhibit D, December 5, 2001 to the filing of the present application January 3, 2002, Applicants' failed to establish diligence. This determination is respectfully traversed.

Applicants: Kenneth H. Rosen
Serial No.: 10/055,104
Filing Date: January 23, 2002
Docket No.: 1209-2
Page 5

The Examiner's attention is called to Exhibit D where the patent application in final form as well as an Assignment, Declaration and Power of Attorney (formal papers) were forwarded to the inventors on December 5, 2001. The formal papers were executed by inventor, John A. Rotondo, on December 11, 2001, less than a week after having been forwarded. Thereafter, on January 17, 2002, the formal papers were executed by inventor, Kenneth H. Rosen. As set forth in the attached Declaration of Agent Garg, the time period between the execution by the inventors and the return of the final pages to Agent Garg can be attributed to review time, mailing and the interim holiday period. It is submitted that this period of time given the above circumstances is not unreasonable. The application was promptly filed on September 23, 2002, a mere five days after execution by the last inventor. Accordingly, it is respectfully submitted that diligence is established for the time period before December 5, 2001 and the actual filing of the application. Reconsideration is respectfully requested.

Having responded in full to the Examiner's objection to the Declaration pursuant to 37 C.F.R. §1.131, it is respectfully submitted that the Sheha et al. reference is effectively overcome.

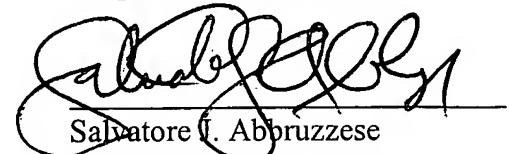
Claims 1-16 and 40-46 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication 2003/0016804 A1 to Sheha et al.

Applicants: Kenneth H. Rosen
Serial No.: 10/055,104
Filing Date: January 23, 2002
Docket No.: 1209-2
Page 6

Furthermore, claims 17-39 are rejected under 35 U.S.C. §103 as being unpatentable over Sheha et al. in view of U.S. Patent No. 5,341,411 to Hashimoto.

In view of the response set forth above, it is respectfully submitted that the Sheha reference is overcome and has been removed as a reference against the claims in the present application. Having done so, it is respectfully submitted that the claims of the present application are patentable over the remaining references of record. The application including claims 1-46 is therefore submitted to be in condition for allowance. Entry of this amendment and favorable action thereon is respectfully solicited.

Respectfully submitted,


Salvatore F. Abbruzzese
Registration No.: 30,152
Agent for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700